

ORIGINAL

MEMORANDUM ENDORSEMENT

DIAGEO NORTH AMERICA, INC. v. W.J. DEUTSCH & SONS LTD.
d/b/a DEUTSCH FAMILY WINE & SPIRITS, and BARDSTOWN BARREL
SELECTIONS LLC, 17 Civ. 4259 (LLS)

Genuine disputes as to material facts:

Whether the statement to the patent office that "The bottle shape is unique and distinctive in the beverage alcohol industry. The bottle shape is readily identifiable and distinguishable from all others in the industry, and accordingly stands out as such on a store shelf or behind a bar even apart from the embossed working and design elements" was fraudulent and known to Diageo to be false.

Whether Diageo has abandoned, by not enforcing, any rights it had to claim originality in the Bulleit bottle design.

Whether the Bulleit bottle design is functional and unentitled to Lanham Act protection. See the full discussion of applicable considerations in Stormy Clime Ltd. v. Pro Group, Inc., 809 F.2d 971 (2d Cir. 1987),

require the denial of plaintiff's motion for summary judgment dismissing defendants' amended counterclaims and affirmative defenses (dkt. 143) and defendants' motion for partial summary judgment (dkt. 133). Diageo's motion to strike evidence (dkt. 148) is denied without prejudice to renewal at trial.

So Ordered.

Dated: New York, New York
March 11, 2020

USDC SDNY DOCUMENT ELECTRONICALLY FILED DOC #: DATE FILED: 3/11/20
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Louis L. Stanton
LOUIS L. STANTON
U.S.D.J.

UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF NEW YORK

MEMO ENDORSED

DIAGEO NORTH AMERICA, INC.,

Plaintiff,

v.

W.J. DEUTSCH & SONS LTD. d/b/a
DEUTSCH FAMILY WINE & SPIRITS, and
BARDSTOWN BARREL SELECTIONS LLC,

Defendants.

Case No. 1:17-cv-04259-LLS

ORAL ARGUMENT REQUESTED

**NOTICE OF MOTION FOR SUMMARY JUDGMENT DISMISSING DEFENDANTS'
AMENDED COUNTERCLAIMS AND AFFIRMATIVE DEFENSES**

PLEASE TAKE NOTICE that upon the accompanying Memorandum of Law, Statement of Undisputed Facts Pursuant to Rule 56.1, Declaration of Gianni P. Servodidio and exhibits attached thereto, and Declaration of Edward Bello and exhibits attached thereto, the undersigned attorneys for Movant-Plaintiff/Counterclaim Defendant Diageo North America, Inc. shall move this Court, before the Honorable Louis L. Stanton, United States Judge for the Southern District of New York, at the Daniel Patrick Moynihan United States Courthouse located at 500 Pearl Street, New York, New York 10007, for an Order dismissing Defendants/Counterclaim Plaintiffs W.J. Deutsch & Sons Ltd. d/b/a Deutsch Family Wine & Spirits and Bardstown Barrel Selections LLC's First, Second, Third, and Fourth Counterclaims and related Fifteenth, Sixteenth, and Seventeenth Affirmative Defenses pursuant to Federal Rule of Civil Procedure 56 and other authorities cited in the accompanying Memorandum, and for such other and further relief as the Court deems appropriate.

MEMO ENDORSED

Dated: February 19, 2020

Respectfully Submitted,

/s/Gianni P. Servodidio

Susan J. Kohlmann
Gianni P. Servodidio
Jacob D. Alderdice
Brittany R. Lamb
JENNER & BLOCK LLP
919 Third Avenue, 38th Floor
New York, NY 10022
Phone 212-891-1600
Fax 212-891-1699
gservodidio@jenner.com

MEMO ENDORSED

**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK**

DIAGEO NORTH AMERICA, INC.,

Plaintiff/Counterclaim Defendant,

v.

**W.J. DEUTSCH & SONS LTD. d/b/a DEUTSCH
FAMILY WINE & SPIRITS, and BARDSTOWN
BARREL SELECTIONS LLC,**

Defendants/Counterclaim Plaintiffs.

ECF CASE

Case No. 1:17-cv-04259-LLS

Hon. Louis L. Stanton

**ORAL ARGUMENT
REQUESTED**

**NOTICE OF DEFENDANTS/COUNTERCLAIM PLAINTIFFS' MOTION FOR
PARTIAL SUMMARY JUDGMENT**

Pursuant to Rule 56 of the Federal Rules of Civil Procedure, Defendants/Counterclaim Plaintiffs W.J. Deutsch & Sons Ltd. dba Deutsch Family Wine & Spirits ("DFWS") and Bardstown Barrel Selections LLC ("Bardstown") (collectively "Deutsch") hereby respectfully move for a partial summary judgment in their favor on:

(a) all claims in the Complaint filed by Plaintiff/Counterclaim Defendant Diageo North America, Inc. ("Diageo"), namely: (i) the First Claim for Trademark Infringement under Section 32(1) of the Lanham Act, 15 U.S.C. § 1114(1); (ii) the Second Claim for Trade Dress Infringement under Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a); (iii) the Third Claim for Dilution under Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c); (iv) the Fourth Claim for Dilution under Section 360-l of the New York General Business Law; (v) the Fifth Claim for Deceptive Acts and Practices under Section 349 of the New York General Business Law; and (vi) the Sixth Claim for Common Law Trademark Infringement and Unfair Competition, *see generally* ECF No. 1;

MEMO ENDORSED

(b) Deutsch's First Counterclaim, which seeks a declaratory judgment of non-infringement and invalidity of the Bulleit trade dress and Diageo's U.S. Trademark Registration No. 3,075,812 (the "'812 Registration'") and Deutsch's Second Counterclaim, which seeks cancellation of the '812 Registration on the grounds of functionality pursuant to 15 U.S.C. §§ 1052(e)(5), 1115(b)(8), and 1119, *see generally* ECF No. 34; and

(c) Deutsch's Fifteenth Affirmative Defense for a finding that Diageo is not entitled to any relief in this action because its alleged bottle design mark and trade dress comprises matter that as a whole is functional, within the meaning of 15 U.S.C. § 1052(e)(5) and is functional within the meaning of 15 U.S.C. § 1115(b)(8), and further that the '812 Registration is invalid and should be cancelled on this ground.

In addition to the above-stated relief, Deutsch further respectfully requests that this Court:

(d) find that this is an exceptional case to merit an award of attorney's fees to Deutsch pursuant to 15 U.S.C. § 1117(a); and

(e) grant to Deutsch any other relief that the Court sees fit.

This motion is supported by a concurrently filed memorandum of law, a Rule 56.1 statement of undisputed facts, as well as concurrently filed declarations of Michael Grow, Thomas Steffanci, Jennifer Thomason, Dr. Michael Rappeport, and Ryan Walsh.

DATED: February 19, 2020

Respectfully submitted,

By: /Michael Grow/
Michael A. Grow, *pro hac vice*
1717 K Street, NW
Arent Fox LLP
Washington, DC 20006
Tel.: (202) 857-6000
Fax: (202) 857-6395
Michael.Grow@arentfox.com

Howard Graff
Eric Biderman
Asra Syed
Lindsay Korotkin
Arent Fox LLP
1301 Avenue of the Americas, Floor 42
New York, NY 10019
Tel.: (212) 484-3900
Fax: (212) 484-3990
Howard.Graff@arentfox.com
Eric.Biderman@arentfox.com
Asra.Syed@arentfox.com
Lindsay.Korotkin@arentfox.com

*Attorneys for Defendants W.J. Deutsch & Sons Ltd.
d/b/a Deutsch Family Wine & Spirits and
Bardstown Barrel Selections LLC*